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No. 1087

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962.

SHAW-BARTON, INC.,
Petitioner,

vs.

JOHN BAUMGARTH CO.,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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The Scheffer Press, Inc.—ANdover 3-6850

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No.

SHAW-BARTON, INC.,

Petitioner,

vs.

JOHN BAUMGARTH CO.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable, the Chief Justice, and Associate Justices of the Supreme Court of the United States:

Petitioner, Shaw-Barton, Inc., prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered January 3, 1963, which reversed a judgment for the petitioner entered by the United States District Court for the Northern District of Illinois on December 14, 1961.

THE OPINIONS BELOW.

The opinion of the District Court and the opinion of the Court of Appeals have not been published in any official reporter system, but are included in the appendix hereto.

JURISDICTION.

The jurisdiction of the Supreme Court is invoked under 62 Stat. 928, U.S.C. §1254(1); 62 Stat. 961 as amended, 28 U.S.C. §2101(c); and 28 U.S.C. 2106.

The opinion and judgment of the Court of Appeals were entered on January 3, 1963.

Plaintiff-Appellant's motion for a rehearing *en banc* was denied on March 6, 1963, and the issuance of the mandate was stayed until May 10, 1963 pending the filing of this petition.

QUESTIONS PRESENTED.

The questions presented are:

1. May a U. S. Court of Appeals, contrary to an inviolable rule of this Court, deny an appellee the right to rely on and to have the benefit of evidence in the record, which could support the judgment of the trial court, by declining to examine the record and evaluate evidence of secondary meaning residing in appellee's trademark, when the Court of Appeals unwarrantedly "assumes" that secondary meaning did not "exist" in the absence of a specific finding by the trial court in those precise words that secondary meaning had been acquired by the trademark?

2. May a U. S. Court of Appeals ignore the clear terms of a decisive statute in the Federal trademark laws, namely, 15 U.S.C. §1052(e) and (f), and, in direct conflict with a leading and controlling decision of the Supreme Court and in direct conflict with decisions on the point rendered by two other Courts of Appeal, rule, in effect, that because a trademark consists of the name of a class of persons who may use the trademarked product,

the mark is *ipso facto* "descriptive" in the sense of the trademark law and incapable of exclusive appropriation, in the absence of a showing that it has acquired a secondary meaning?

STATUTES INVOLVED.

The statutes and the Civil Procedure Rule involved are: 28 U.S.C. §1254; 28 U.S.C. §2101; 28 U.S.C. §2106; 15 U.S.C. §1122; 15 U.S.C. §1052(e) and (f); and Rule 52(a) of the Federal Rules for Civil Procedure. They are annexed hereto in the appendix.

STATEMENT OF THE CASE.

This action was instituted in the U. S. District Court at Chicago, Illinois pursuant to the provisions of 15 U.S.C. §1114; 15 U.S.C. §1116; 15 U.S.C. §1117 15 U.S.C. §1118; 15 U.S.C. §1121; Act of 1946 Sec. 46(b) (Lanham Act).

Plaintiff, Shaw-Barton, Inc., and defendant, John Baumgarth Co. are competitors in the manufacture and sale of calendars to be sold to advertisers, who in turn distribute the calendars free of charge to their customers and prospective customers.

Late in 1940, plaintiff created a 12 sheet calendar with a picture in natural colors positioned at the top of each monthly calendar sheet and the first of these were sold in 1941 for hanging in the year 1942.

At the outset, plaintiff adopted the word HOME-MAKER'S as its trademark on this wall calendar and Registration No. 395,312 was granted to plaintiff, under the trademark Act of 1905 on May 19, 1942, and the mark has been in continuous use since. The registration is shown as Pl. Ex. 1 at page 18 of the large Defendant-Appellant's Exhibit Book.

Black and white photographic prints of a portion of plaintiff's 1942 calendar (Pl. Ex. 6A) and of plaintiff's 1946 calendar (Pl. Ex. 6) are shown in pages 22 to 27 of said Exhibit Book, but these fail to depict the eye appeal which undoubtedly accounts for the commercial success of the HOME-MAKER'S calendars. So that the Supreme Court may see the originals in color, as the trial judge did, four original colored exhibits have been certified and transmitted to this Court in a separate large binder. They are indexed and fully described in the EXHIBIT BOOK index.

Sales by plaintiff of its HOME-MAKERS calendars mounted rapidly, as evidenced by Pl. Ex. 25 and 27, (Exhibit Book pp. 53, 54). No evidence was adduced that anyone other than plaintiff was using this trademark, until defendant began to use it in 1948 on its sales samples for sellings its calendars, as illustrated in Pl. Ex's. 7A to 7K (Exhibit Book pp. 30-40). Following 1948, when plaintiff sold nearly one million calendars, plaintiff's annual sales of its HOME-MAKERS calendars decreased markedly.

Plaintiff sold its calendars direct to the advertisers through its own staff of salesmen, whereas defendant's calendars were sold only through jobbers. There is no dispute over the difference in these sales methods.

In the spring of 1950, plaintiff learned of defendant's infringement of the trademark and wrote a warning letter dated April 25, 1950 (Pl. Ex. 3) to which Mr. John Baumgarth, President of defendant, replied under date of April 28, 1950 (Pl. Ex. 4), these letters appearing at pages 19 and 20 of the Exhibit Book. Defendant's 1951 sample calendar, then on sale, appears as Pl. Ex. 7C at p. 33. A discrepancy between the reply letter and that sample calendar may be observed.

Shortly thereafter, within a couple of weeks, Mr. Warren Pomerene, counsel for plaintiff, talked with Mr. Baumgarth

about the infringement (without knowledge of the existence of the 1951 sample calendar) and was assured that Baumgarth would not further infringe. (Def. App. 15-19 and Pl. App. 12-13) Mrs. Baumgarth, when called by plaintiff as an adverse witness, denied that the above telephone conversation ever occurred. (Def. App. 64-68) The Trial Judge evidently believed Mr. Pomerene and not Mr. Baumgarth. (Def. App. 108-109, 114)

Plaintiff did not discover for some time that defendant, despite the assurances given in April and May of 1950, continued to infringe the trademark. Defendant's 1955 calendar (Pl. Ex. 15 Exhibit Book pp. 51, 52), having come to plaintiff's attention, caused Mr. Stevning, Vice President of Shaw-Barton, to instruct Mr. Pomerene (Def. App. 84) in December 1954 (Def. App. 19) to file this suit. The suit was filed at Chicago on January 13, 1955.

REASONS FOR GRANTING THE WRIT.

Appellee may urge any and all parts of record to support the decree below.

The first question arises because of two sentences in the last brief paragraph on page 2 of the majority opinion in this case, reading as follows:

> "The trial judge made no finding that the term 'Homemakers' as applied to calendars had acquired a secondary meaning. In the absence of such finding, we may assume that none existed. *Wilhartz* v. *Turco Products*, 164 F. 2d 731 (7th Cir. 1947)."

In the last sentence "none" apparently means "secondary meaning," so that the conclusion stated is that "we may *assume* that no *secondary meaning* existed."

That assumption plainly and undeniably rules out the existence of secondary meaning without even considering

what evidence there may be in the record to establish that plaintiff's (petitioner's) mark had acquired a secondary meaning.

This assumption brings up immediately two separate and distinct points. Chief Judge Hastings in his dissenting opinion, discussed the trial judge's comments on the evidence, and stated that the findings of Judge Robson sufficiently satisfied the doctrine of secondary meaning. More on this point later.

The second point is, may the court of appeals, through its majority opinion, legally render a judgment based upon its illegal assumption? The Supreme Court has repeatedly said it may not.

In *Morley Construction Co.* v. *Maryland Casualty Co.*, 300 U. S. 185, 191; 81 L. Ed. 593, 597, this Court said that without a cross-appeal, an appellee may "urge in support of a decree any matter appearing in the record although his argument may involve an attack upon the reasoning of the lower court or an insistence upon matter overlooked or ignored by it. *American Railway Express Co.*, 265 U. S. 425, 435. * * * The rule is inveterate and certain." (numerous cits. follow)

The leading case on this point seems to be *United States* v. *American Railway Express Co.*, 265 U. S. 425, 435; 68 L. Ed. 1087, 1093 (1924), wherein Mr. Justice Brandeis said:

> "But it is likewise settled that appellee may, without taking a cross-appeal, urge in support of a decree any matter appearing in the record although his argument may involve an attack upon the reasoning of the lower court, or an insistence upon matter overlooked or ignored by it. By the claims now in question, the American does not attack, in any respect, the

decree entered below. It merely asserts additional grounds why the decree should be affirmed. These grounds will now be examined."

The above quoted *U. S.* v. *American Rwy. Express* case was cited and followed in *Wright* v. *McLaury*, 7 Cir. 81 F. 2d 96, 99, (1936) and again cited and followed in *Cusack* v. *Longaker*, 2nd Cir. 95 F. 2d 304, 305 (1938).

However, the *U. S.* v. *American Rwy. Express* case, not having been followed by the 7th Circuit in a later case, was invoked in *Jaffke, Petitioner, on Writ of Certiorari* v. *Dunham*, 352 U. S. 280; 1 L. Ed. 2d 314, 315, to review a judgment of the 7th Circuit reported at 229 F. 2d 232, and this Court remanded the case to the 7th Circuit to comply with the *U. S.* v. *American* rule.

The majority opinion relies on *Wilhartz* v. *Turco Products*, 164 F. 2d 731 (7th Cir. 1947) as authority for its assumption. A somewhat similar assumption as to the absence of secondary meaning was introduced into that case *sua sponte* by Judge Minton, then in the 7th Circuit, *but* he applied it against an *appellant, not an appellee*, and therefore did not contravene the rule of the *U. S.* v. *American Rwy. Express* case. Moreover, he said, at page 733,

> "We find no evidence in the record that would compel a different conclusion. There is substantial evidence in the record to support the District Court's finding, and it is not clearly erroneous. The witnesses seemed to associate the defendant's product with the dominating mark 'Turco' and not 'Auto Shampoo' or 'Car Shampoo.' There was no showing as to secondary meaning as would warrant us in reversing the District Court for failure to so find."

The *Wilhartz* v. *Turco* case, was not quoted from by Defendant-Appellant but was cited in the present suit to

the court by Defendant-Appellant as being applicable to an appellee.

As far as can be learned from the published decisions, no other Court of Appeals in the United States has applied the "absent finding" rule against an appellee as the 7th Circuit has done in this suit—*and in this suit, only.*

The 7th Circuit in two recent trademark suits, even though there was lacking a specific finding by the trial court in each case that secondary meaning had been established, nevertheless examined the record for evidence of secondary meaning and affirmatively found in each case that it did exist. Chief Judge Hastings cited one of these two cases, *i.e., Le Blanc Corp.* v. *H. & A. Selmer Inc.*, 7 Cir. 310 F. 2d 449, 456 (Nov. 21, 1962).

The other recent decision was in *Fuller Products Co.* v. *Fuller Brush Co.*, 7 Cir. 299 F. 2d 772, 776 (Feb. 13, 1962).

In view of the fact that the Supreme Court has firmly settled an appellee's *right to urge any matter of record* which will *support* the *decree* of the trial court, it is respectfully submitted that it is not discretionary with an appellate court to concede that right to some appellees and withhold it from others. This situation, however, seems to be frequent in the 7th Circuit, and the denial of the right will likely recur unless this Court in this suit takes corrective measures.

PROOF OF SECONDARY MEANING IS NOT NEEDED TO ESTABLISH VALIDITY OF SUGGESTIVE MARK.

The probable frequency of occurrence of the problem discussed above is inherent in suits involving "suggestive" marks.

In the carefully considered decision by the trial judge, the Court concluded that HOME-MAKERS is not "descriptive" in the trade mark sense; but "would seem to fall more nearly within the classification of a "suggestive" phrase capable of registration under the Act of 1905" (Def. App. 110).

In *Huntington Laboratories* v. *Onyx Oil and Chemical Co.*, 165 F. 2d 454 (CCPA—1948) the Court held that the syllable "San" was not descriptive but suggestive, saying: "As such, it is admittedly suggestive when applied to appellant's products, and it may be said that, so far as we are advised, it has never been deemed necessary in order to establish the validity of a suggestive mark to show that it had acquired a secondary meaning. Indeed, an effort to show that a word has acquired a secondary meaning carries with it the implication that such a word is regarded by its proponent as being either descriptive or geographic or as having some quality which would normally preclude its registration as a trademark."

Thus, under the law, there was no need for plaintiff to urge nor the trial judge to find that secondary meaning had been established.

THE RECORD CONTAINS AMPLE PROOF THAT SECONDARY MEANING, IF NEEDED BY "HOME-MAKERS" HAD BEEN ESTABLISHED.

Trial Judge Robson and Chief Judge Hastings directed attention to some of this evidence of secondary meaning.

Judge Hastings noted that plaintiff had sold over 11,500,000 "HOMEMAKERS" calendars from 1941 to 1959 and nearly one million in the year 1948 when defendant began its sales of similar calendars (under the plaintiff's trademark).

Both Judge Hastings and Judge Robson noted that there was testimony by purchasers that they identified the trademark with plaintiff's product—and it could not be otherwise as Shaw-Barton's own staff of salesmen were instructed to make full use of the trademark as an exclusive registered name. (Testimony of J. S. Shaw—Def. App. 106.) One hundred or three hundred purchasers testifying on this point could not testify otherwise. Judge Robson listened to this testimony.

It is proper and customary for judges to make their own observations, deductions and to draw inferences from exhibits, testimony and from silence itself. The sample calendars employed by defendant's jobbers from 1948 to 1952, as illustrated by Pl. Exh. 7A to 7E each bore *an adequate identifying title* of "Modern Home Calendar." But on defendant's samples, seen only by the jobber salesmen and prospective purchasers (but not on the calendars actually shipped to the purchasers with their advertising printed thereon for hanging in homes or public places) *defendant also imprinted plaintiff's trademark in extra large letters.*

Two natural inferences may be drawn from this conduct. First, it was an admission by defendant that it knew plaintiff's trademark was widely known and identified the product with the company for whom the Shaw-Barton salesmen were working. Defendant knew the mark had acquired a valuable secondary meaning.

The second inference is that the use of the mark in the sales interview and later withholding it from general public viewing was evidence of a sly plan to trade on the mark's goodwill and as far as possible reduce the chances of detection.

The absence of the Baumgarth name from these samples aided both purposes.

In the history of trade mark infringement it is believed that the Baumgarth plan is without a parallel.

If the Court of Appeals for the Seventh Circuit had looked in the record for evidence that the mark had acquired a secondary meaning and that defendant's conduct constituted an irrefutable admission thereof, the Court would have found that the record was replete with such evidence.

The Court would have found that from 1941 up to 1948 (when the infringement began) plaintiff had sold nearly 4 million of its calendars and almost another million during 1948 under the mark without known infringers and as 15 U.S.C. 1052(f) provides that 5 years of continuous exclusive use is "*prima facie* evidence that the mark has become distinctive," these facts alone would amply establish secondary meaning.

While it is a time honored custom for those accused of trade mark infringement to take the witness stand and lamely or credibly explain why they adopted the complainants' marks, the defendant corporation and its President offered no such explanation under oath. Judge Robson heard the trial for four days, and very likely drew the proper inferences from this unexplained silence.

Thus, it may now be recognized that not only did the majority opinion in this appeal contravene the settled Supreme Court law with respect to an appellee's *right* to use any evidence of record to sustain the trial court decree, but the evidence deemed important under the majority view of the case was right there in the record, but had been ignored on the basis of an untenable assumption.

It is well settled that a trial judge is neither required nor expected to make every possible specific finding of

fact which could be made. It is generally held to be sufficient if he includes only such findings as furnish support for his judgment. Here, the trial judge, Edwin A. Robson, found the mark was *not* "descriptive" in the trademark sense but was "suggestive." A suggestive mark needs no support in secondary meaning.

JUDICIAL INTERPRETATION OF TRADE MARK STATUTE 15 U.S.C. 1052(e).

Petitioner's Second Question involves interpretation by a court of whether a registered trademark is invalid as a descriptive trademark if it consists of a word or phrase which is the name of a class of purchasers or users for whom the trademarked goods are intended, or may be valid as a merely suggestive mark.

The Court of Appeals for the 8th Circuit in 1947, in *Hanson* v. *Triangle Publications, Inc.*, 163 F. (2d) 74 (74 USPQ 280) held that "Seventeen" applied as the name of a publication of special interest to young women and girls was "an arbitrary and fanciful mark as applied to a publication," and held the registered mark to be valid, without comment on secondary meaning.

The Court of Customs and Patent Appeals in 1953, in a very carefully worded opinion discussing the interpretation of this statute, reported as *Bonne Belle, Inc.* v. *Lanolin Plus Cosmetics, Inc.*, 202 F. 2d 790 (97 USPQ 147) held that "Plus 30" applied to a cosmetic, even though advertised for use by women over 30 years of age, was not descriptive of the goods, and was a valid registered mark,—without comment on secondary meaning.

The Supreme Court in *Hamilton-Brown Shoe Co.* v. *Wolfe Bros.* 240 U.S. 257 (1916), on a review granted upon a petition for writ of certiorari, in an extensive and care-

fully worded opinion, held that "American Girl" as applied to women's shoes was a valid registrable mark, also without specific reference to secondary meaning.

In the present suit, on page 3 of the majority opinion, the Court of Appeals for the 7th Circuit cited both the *Hamilton-Brown Shoe* case and the *Bonne Belle* case in *support* of its decision invalidating "HOME-MAKERS" as a trademark. The phrases recited in the subject opinion, preceding such citation, are not garnered from the cited cases, which is sufficiently mystifying, but neither decision supports, but in fact contradicts the conclusions stated in the subject opinion,—adding further to the mystification.

The effect, not legally, of course, but as a proclamation of judicial determination of law, was to overrule both the Supreme Court and the Court of Customs and Patent Appeals, and, by inference, the herein mentioned decision in the 8th Circuit.

The rationale of the subject opinion is, perhaps, revealed in its later paragraph which discusses the "carpenter" and his tools. It is revealing that in each example, the opinion mentions the ordinary and necessary tools used in the carpenter's occupation.

There is no testimony in this record that calendars are and ordinary and necessary tool, appliance or device usually any more associated with the occupation of a housewife or homemaker, than with the occupation of any other person.

This is especially true, when it concerns what is in fact an advertising calendar, paid for by the advertiser, very prominently bearing his advertising, which may be displayed on a home wall or other wall only at the sufferance of the recipient.

The page fronts, which are always on view, would be as acceptable on any office wall. Many of these colored pictures are good enough for framing.

The Baumgarth Co., before it retained an attorney after suit was filed against it, had high praise for the fronts of its calendar pages, an example of which appears in Pl. Exh. B-1 (Exhibit Book p. 32), where appears this statement

> "Twelve magnificent pictures in color—and all retaining the beauty and color of their original kodachromes and paintings! There's no monotony in the Homemaker's calendar; there are twelve different pictures to change as the months and seasons change. You'll revel in the breath-taking landscapes . . . in fact, you'll be reluctant to turn the page when the next month rolls around."

Defendant's advocate had no praise for the fronts, but dwelt upon the contents of the page backs, with sufficient emphasis to convince the Court of Appeals, perhaps, that the normally out-of-sight backs give the calendar its primary character.

It is a well known fact that housewives are deluged with cook books, recipes and household hints in magazines and newspapers. It is fair to conclude that the printed matter on the page backs does not give the calendars of both parties its *dominant* character, but in truth is of little more significance than a dusting of sugar on the doughnuts, or the decorative cherry in the manhattan, which often remains when the glass is otherwise empty, and in no event converts this popular alcoholic cocktail into a mere fruit cocktail or fruit punch.

It is believed that the conflicts with other court decisions mentioned above, the disregarding of the import

of the *Hamilton-Brown* decision, and the 7th Circuit interpretation of the cited statute, recommend the granting of this writ.

CONCLUSION.

Wherefore, petitioner prays that its petition be granted, that the case be reviewed, and reversed, with affirmance of the judgment of the District Court, as was done in *Story Parchment Co.* v. *Patterson Parchment Paper Co.*, 282 U. S. 555, 567.

Respectfully submitted,

FRANK J. FOLEY
Attorney for Petitioner

APPENDIX.

IN THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 13697 SEPTEMBER TERM, 1962 SEPTEMBER SESSION, 1962

SHAW-BARTON, INC.
Plaintiff-Appellee,
v.
JOHN BAUMGARTH CO., INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

January 3, 1963

Before HASTINGS, *Chief Judge,* SCHNACKENBERG, and SWYGERT, *Circuit Judges.*

SWYGERT, *Circuit Judge.* This suit was instituted under the federal trademark statutes, 15 U. S. C. § 1051 *et seq.*, by plaintiff, Shaw-Barton, Inc., charging defendant, John Baumgarth Co., Inc., with infringement of plaintiff's registered trademark "Homemakers" as employed on calendars, and asking for an injunction and recovery of plaintiff's damages and defendant's profits resulting from the unlawful infringement.

The District Court found the trademark valid and infringed and decreed that an injunction should issue against defendant. The judgment provided for the recovery of all

damages sustained by plaintiff including all profits realized by defendant from its infringing sales. From the judgment defendant appeals.

Plaintiff's trademark was registered on May 19, 1942. The calendar to which plaintiff has applied its trademark consists of twelve sheets, one for each month, each sheet having at its top a large, full-color picture. There is a space below each picture for the advertiser's name and message; below that are the calendar dates for the current month, with space adjoining each date for such notes as the user might wish to insert. On the back of each sheet are items of information that would be of particular interest to one whose occupation is household and family management.

Plaintiff began to sell its "Homemakers" calendars in 1941, but no notice that the mark was registered was printed on any calendar until several years after this suit was filed.

In 1948, defendant began selling calendars identical in format with plaintiff's. The sample calendars, which defendant distributed to its jobbers to be exhibited by the jobbers' salesmen when soliciting orders from prospective advertisers, bore in the sample ad space below the picture, this notation:

> This homemaker calendar
> is a calendar out of the ordinary
> will be retained the full year
> and appreciated as a gift

The words "This homemakers calendar" were printed in type two and one-half times the height of the rest of the words. During the period 1949 to 1953, orders were obtained by the jobbers' salesmen by means of the samples bearing the word "Homemakers." These orders were sent to defendant who printed the appropriate advertiser's name in the ad space on each of the twelve sheets in place of the statement "This homemakers calendar, etc." The

calendars were then shipped to the advertisers minus the word "Homemakers;" they did, however, carry the name "Modern home calendar." After 1954, defendant's calendar samples carried the further identification "Modern homemaker calendar" just below the name of the month.

The evidence clearly shows that defendant was informed of plaintiff's trademark claims at least as early as 1950, but continued to use the identifying markings described above. Plaintiff acknowledges that defendant has the right to copy the format of plaintiff's calendars and makes no claim of exclusive rights thereto.

The trial judge made no finding that the term "Homemakers" as applied to calendars had acquired a secondary meaning. In the absence of such a finding, we may assume that none existed. *Wilhartz* v. *Turco Products*, 164 F. 2d 731 (7th Cir. 1947). There was no evidence of likelihood of confusion among the purchasing public. Though confusion may be inferred under certain circumstances, it is of little consequence if it results from the use of identifying marks that lie in the public domain and which have acquired no secondary meaning.

The question thus presented is the correctness of the District Court's determination that "[p]laintiff's trademark 'Homemakers' is a good and valid trademark. . . ."

We hold that the word "Homemakers," when applied to calendars of the type involved in this suit, is a noun,[1] descriptive of that class of individuals toward which the design and proposed use of the product is oriented; that the class is total in the sense that it is not effectively limited to less than the whole—which limitation would render it less descriptive and more of a fanciful designation, arbitrarily selected by the applicant (see *Hamilton Shoe*

[1] Websters Third New International Dictionary (unabridged, 1961), contains the following definition of homemaker:

> home maker, n. 1: one that makes a home: one whose occupation is household and family management. . . .

Co. v. *Wolf Brothers*, 240 U. S. 257 (1916)); that the mind readily and immediately recognizes the association between the product and the class of users (see *Bonne Bell, Inc.* v. *Lanolin Plus Cosmetics*, 202 F. 2d 790 (C. C. P. A. 1953)); and therefore, it is not capable of exclusive appropriation as a trademark in the absence of a showing that it has acquired a secondary meaning.

It is well established that where descriptive words are used, the presumption of validity attaching to a registered trademark may be easily overcome. *John Morrell & Co.* v. *Reliable Packing Co.*, 295 F. 2d 314 (7th Cir. 1961).

The fact that here we are confronted with a word that is descriptive of the class of users for which the product is primarily and particularly oriented, rather than a word that is descriptive of the inherent qualities or characteristics of the product itself, distinguishes those cases that deal with the latter category, *e.g.*, *Independent Nail & Pack. Co.* v. *Stronghold Screw Prod.*, 205 F. 2d 921 (7th Cir. 1953); *General Shoe Corp.* v. *Rosen*, 111 F. 2d 95 (4th Cir. 1940).

The controlling statute, 15 U. S. C. § 1052(e), precludes registration of any mark that is descriptive "when applied to the goods" on which it is to be used. When the trademark, "Homemakers" (with or without a hyphen), is juxtaposed to the calendar in question, the mind readily and immediately assents to the association as being appropriate, and recognizes without reflection the identity of the group or class for whose use the product was intended. In this connection, it is enlightening to note that plaintiff also sells calendars entitled a "Catholic Church" calendar, a "Jewish Home" calendar, a "Protestant" calendar, and a "Lutheran Church" calendar. Plaintiff concedes that these names would not be subject to being trademarked. Though the word "carpenter," by itself, does not indicate any particular context in which we might use it, nevertheless, it must be apparent that, in the absence of some secondary meaning, no one should be permitted to trademark the word in such forms as "carpenter's" ladders,

"carpenter's" hammers, "carpenter's" saws, etc. We believe the word "Homemakers" as used on calendars of the type here in question falls in the same category, and hence it ought not be granted trademark protection.

The trial judge's finding that the word "Homemakers" is not descriptive is thus clearly erroneous. Accordingly, the judgment of the District Court is reversed.

HASTINGS, *Chief Judge*, dissenting.

I respectfully dissent. I cannot agree that the district judge "* * * [M]ade no finding that the term 'Home-makers' as applied to calendars had acquired a secondary meaning."

It is apparent to me that the opinion of the majority is based largely upon the assumption that the trial judge made no finding as to secondary meaning and, therefore, the assumption is warranted that none existed.

The trial judge gave a good description of plaintiff's calendars saying that "[T]he testimony reveals that plaintiff's calendar featuring the word 'HOME-MAKERS' consists of a careful assembly of attractive pictures, editorial material of interest to a housewife, such as recipes, household and gardening hints, convenient place for notations of telephone numbers and memoranda, budget advice and charts, and a place for the advertisement name and data."

Plaintiff sold over 11,500,000 "HOME-MAKERS" calendars from 1941 to 1959. In the year 1948, plaintiff sold nearly one million "HOME-MAKERS" calendars. It was in this year that defendant began selling calendars identical in appearance and makeup with plaintiff's calendars.

The trial court found "[T]here was testimony of several witnesses, purchasers of calendars, identifying the word 'HOME-MAKERS' with plaintiff's product * * * and that in the purchase of calendars they identified them by the name 'HOME-MAKERS.'"

It is true the trial court did not find in so many words that a secondary meaning attached to the word "HOME-MAKERS" for wall calendars; but the Court did specifically find from the testimony of witnesses who were purchasers of calendars that they identified "HOME-MAKERS" with plaintiff's product. In my view, this sufficiently satisfies the requirements of the doctrine of secondary meaning. We reached a similar conclusion in a like situation in *G. Leblanc Corporation* v. *H. & A. Selmer, Inc.*, 7 Cir., ... F. 2d ..... (November 21, 1962).

I also agree with the finding of the trial court "[W]hile at first blush the word 'HOME-MAKERS' in apposition to the word calendar might be deemed descriptive thereof, the Court has concluded after a careful study of the precedent, that it is not 'descriptive in the trademark sense so as to invalidate the registration.'"

The district court, in a carefully considered memorandum decision on the merits of this case, found support for its holding in *Independent Nail & Pack. Co.* v. *Stronghold Screw Prod.*, 7 Cir., 205 F. 2d 921, 925 (1953), cert. denied, 346 U. S. 886. I think its reliance on this case was well founded. It has long been recognized as the law of this circuit and has been cited with approval many times by this and other courts. The majority opinion seeks to distinguish it from the case at bar: I cannot agree that it is distinguishable.

Finally, after seeking refuge in our holding in *Wilhartz* v. *Turco Products*, 7 Cir., 164 F. 2d 731 (1947) on the issue of secondary meaning, the majority opinion notes "[T]here was no evidence of likelihood of confusion among the purchasing public." The relevance of "likelihood of confusion" usually is found on issues of infringement and unfair competition. I fail to see its application to the issue of validity of plaintiff's trademark which is the question treated in the majority opinion.

I would affirm the judgment of the district court.

UNITED STATES COURT OF APPEALS

For The Seventh Circuit

Chicago 10, Illinois

Thursday, January 3, 1963

Before

Hon. John S. Hastings, Chief Judge

Hon. Elmer J. Schnackenberg, Circuit Judge

Hon. Luther M. Swygert, Circuit Judge

SHAW-BARTON, INC.,
Plaintiff-Appellee,

No. 13697 *vs.*

JOHN BAUMGARTH CO., INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, REVERSED, with costs, in accordance with the opinion of this Court filed this day.

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Wednesday, March 6, 1963

Hon. John S. Hastings, Chief Judge

Hon. F. Ryan Duffy, Circuit Judge

Hon. Elmer J. Schnackenberg, Circuit Judge

Hon. Win G. Knoch, Circuit Judge

Hon. Latham Castle, Circuit Judge

Hon. Roger J. Kiley, Circuit Judge

Hon. Luther M. Swygert, Circuit Judge

SHAW-BARTON, INC.,
Plaintiff-Appellee,

No. 13697 *vs.*

JOHN BAUMGARTH CO., INC.,
Defendant-Appellant.

} Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

It Is Ordered by the Court that the petition for rehearing *en banc* of this cause be, and the same is hereby DENIED. (Knoch, *C.J.* disqualified himself from sitting on this case).

28 U.S.C. § 1254. *Courts of appeals; certiorari; appeal; certified questions.*

"Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment of decree; • • •"

28 U.S.C. § 2101. *Supreme Court; time for appeal or certiorari; docketing; stay.*

"(c) Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A Justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days."

28 U.S.C. § 2106. *Determination.*

"The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances. June 25, 1948, c. 646, 62 Stat. 963."

Sec. 32 (1). *Remedies—Infringement*

Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such

goods or services; or (b) reproduce, counterfeit, copy, or colorably imitate any such mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale in commerce of such goods or services, shall be liable to a civil action by registrant for any or all of the remedies hereinafter provided, except that under subsection (b) hereof the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such mark is intended to be used to cause confusion or mistake or to deceive purchasers (15 U. S. C. 1114 (1)).

Sec. 34. *Remedies—Injunctions*

The several courts vested with jurisdiction of civil actions arising under this Act shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent Office (15 U. S. C. 1116).

Sec. 35. *Remedies—Recovery for violation of rights*

When a violation of any right of the registrant of a mark registered in the Patent Office shall have been established in any civil action arising under this Act, the plaintiff shall be entitled, subject to the provisions of sections 29 and 31* (1) (b), and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is

* The figure 31 apparently should be 32.

either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty (15 U. S. C. 1117).

Sec. 36. *Remedies—Destruction of infringing labels and the like*

In any action arising under this Act, in which a violation of any right of the registrant of a mark registered in the Patent Office shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed (15 U. S. C. 1118).

Sec. 39. *Remedies—Jurisdiction of courts*

The district and territorial courts of the United States shall have original jurisdiction, the circuit courts of appeal of the United States and the United States Court of Appeals for the District of Columbia shall have appellate jurisdiction, of all actions arising under this Act, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties (15 U. S. C. 1121).

Sec. 40. *Remedies—Review by Supreme Court.*

Writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for in cases under the patent laws (15 U.S.C. 1122).

Trademarks registrable on the principal register

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

• • •

(e) consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 4 hereof, or (3) is primarily merely a surname;

(f) except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the 5 years next preceding the date of the filing of the application for its registration (15 U. S.C. 1052, amended by Public Law 593, 82d Cong., approved July 19, 1952, 66 Stat. 792).

Rule 52. *Findings by the Court. F.R.C.P.*

(a) EFFECT. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Request for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein.

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No. 1087

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962.

SHAW-BARTON, INC.,
Petitioner,

vs.

JOHN BAUMGARTH CO., INC.,
Respondent.

On Petition For A Writ of Certiorari
To The United States Court of Appeals
For the Seventh Circuit

BRIEF OF RESPONDENT IN OPPOSITION

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The Scheffer Press, Inc.—ANdover 3-6850

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IN THE

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OCTOBER TERM, 1962.

No. 1087

SHAW-BARTON, INC.,

Petitioner,

vs.

JOHN BAUMGARTH CO., INC.,

Respondent.

On Petition For A Writ of Certiorari
To The United States Court of Appeals
For the Seventh Circuit

BRIEF OF RESPONDENT IN OPPOSITION

The Petition fails to set forth any "special and important" reasons why it should be granted, as required by rules of this Court.

STATEMENT

This litigation involves the question of the validity as a trademark of the term "Homemakers" or "Homemakers Calendar" as applied to kitchen calendars of the type filled with editorial matter of interest to a housewife in the management of the home—a homemaker.

The Court of Appeals held that the term is descriptive of the specific type of calendar here involved, particularly in this industry wherein titles are used for different calendars to designate their editorial content, such as the titles "Catholic Church" calendar, "Jewish Home" calendar, "Protestant" calendar, and "Lutheran" calendar. The Court of Appeals noted that Petitioner conceded that those names are not subject to being trademarked. The Court also found that the term "Homemaker" had not acquired a secondary meaning.

REASONS FOR DENYING THE WRIT

THERE ARE NO SPECIAL AND IMPORTANT REASONS FOR GRANTING THE WRIT

The decision in this case is of very narrow importance —it is limited to (a) the particular term "Homemakers", (b) as applied to one particular type of calendar, (c) in an industry wherein names are applied to calendars determined by the editorial content thereof and are recognized as not subject to being trademarked. There is nothing "special" about this case, nothing of general "importance". No new principles of law are involved. The issue in this case is of importance only to the parties in this suit.

THE DECISION IS IN CONSONANCE WITH THE DECISIONS OF THIS COURT

The decision of the Court of Appeals turned on the simple issue of whether or not the word "homemakers", as applied to the type of calendars here in issue, is descriptive of those calendars. The test of descriptiveness, within the meaning of trademark law, has been repeatedly announced by this Court. *Standard Paint Co.* v. *Trinidad Asphalt Mfg. Co.*, 1911, 220 U.S. 446, 453, 454; *Warner*

and Co. v. *Eli Lilly and Co.*, 1924, 265 U.S. 526, 528. In the latter case, this Court stated (p. 528):

> "A name which is merely descriptive of the ingredients, qualities, or characteristics of an article of trade cannot be appropriated as a trademark and the exclusive use of it afforded legal protection. The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong."

The Court of Appeals considered the word "homemakers" in light of the particular type of calendars here involved, applied in the above-quoted principles of law laid down by this Court, and reached the conclusion that the word is descriptive, and therefore not capable of appropriation as a trademark. The Court did not announce any new test of descriptiveness nor did it depart from the established principles of law on this point.

THERE IS NO CONFLICT OF DECISIONS

The decision of the Court of Appeals in this case is not in conflict with any of the decisions cited in the Petition. The cases are distinguishable on their facts. In determining whether or not a word is descriptive of certain goods, this Court and other courts have taken the *ad hoc* approach to the question, since in each case a *specific* word must be evaluated in light of the *specific* goods upon which the word is used. Therefore, the fact that some other word, as applied to some other goods, is not descriptive, is not determinative of whether or not "Homemakers" is or is not descriptive of the specific calendars upon which that word is used. In this case, as in the cases cited at pages 12-13 of the Petition, the same *test* of descriptiveness was applied,

but different conclusions were reached because the marks were different and the goods involved were different.

REBUTTAL OF PETITIONER'S REASONS

Petitioner urges four reasons for the granting of the requested writ. These may be rebutted as follows:

Alleged reason one: Appellee may urge any and all parts of the record to support the decree below.

Answer: The Petition does not assert that Petitioner was denied that right by the Court of Appeals. Therefore, this is not a proper reason for granting the writ.

Alleged reason two: Proof of secondary meaning is not needed to establish validity of "suggestive" mark.

Answer: The above principle is not involved here. The Court of Appeals held that the term here involved is "descriptive". It rejected plaintiff's contention that the term is "suggestive".

Alleged reason three: The record contains ample proof that secondary meaning, if needed by "Homemakers" had been established.

Answer: *The Court of Appeals disagreed. Such disagreement with Petitioner is not ground for certiorari.* Petitioner erroneously concludes that the Appellate Court did not consider the entire record before it in finding an absence of secondary meaning, because the Court stated that in the absence of a finding of secondary meaning by the trial court, "we may assume that none existed". The Court's statement that "we *may* assume that no secondary meaning existed" is the equivalent of "we *do* assume that no secondary meaning existed" because a study of the record failed to lead to a different conclusion. It

was clearly the Appellate Court's opinion that there is not sufficient evidence to support a finding of secondary meaning, and that the trial court's opinion was to the same effect on this point. *It is plaintiff's failure to prove secondary meaning that leads to the assumption that none existed, and that is the reason for no finding of secondary meaning by the trial court* and by the Appellate Court.

The assertion (p. 11 of Petition) that 15 U.S.C. 1052(f) is applicable was first raised in Petitioner's "Reply Brief In Support of Petition For Rehearing" filed in the Court of Appeals. The Court found it lacking in merit. This section of the statute is inapplicable to the facts in this case. This section of the statute is directed *solely* to the Commissioner of Patents and provides that he *may* accept certain facts as prima facie evidence of distinctiveness, as a prerequisite to registration. The statute is permissive, not mandatory. The required facts never were presented to the Commissioner (nor to the Court) and there is no reason for presuming that had they been presented, the Commissioner would have found the mark distinctive. He may very well have found otherwise. The Court of Appeals found the mark lacking in distinctiveness.

Alleged reason four: Judicial interpretation of trademark statute.

Answer: In each of the cases cited by Petitioner under this heading the term there in issue was non-descriptive. Therefore, no proof of secondary meaning was needed. In the present case the term is descriptive, as held by the Court of Appeals. This is fatal to its validity as a trademark where a secondary meaning has not been *proved*.

Petitioner's assertion that it "created" a 12 sheet picture calendar having an "eye appeal which undoubtedly accounts for the commercial success", if true, is irrelevant, for defendant (respondent) has not been charged with copying plaintiff's (petitioner's) calendar and, as is pointed out by the Court of Appeals,

> "Plaintiff acknowledges that defendant has the right to copy the format of plaintiff's calendars and makes no claim of exclusive rights thereto".

Petitioner urges that the editorial matter on the backs of the calendar pages is of little significance (page 14 of Petition). *The Court of Appeals did not agree.* Factually, Petitioner is arguing contrary to the testimony given by its own witnesses. Petitioner's witness, Sadak, testified (Appendix, pp. 33 and 34) that he became attached to this type of calendar because

> "It had on the back of each sheet some very valuable information that the housewife appreciated in the way of cooking and so forth—different meals, recipes, and so forth."

Petitioner's witness, Durkin, testified to the same effect. (Appendix p. 44).

CONCLUSION

Where review by certiorari is sought on the basis of an alleged conflict, there must in fact be a conflict, a real and embarrassing conflict. In *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al,* 1923, 261 U.S. 387, 393, this Court held:

"it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit court of appeal."

There is no basis on which the Petition can be granted, and, accordingly, we pray that it be denied.

Respectfully submitted,

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No. 1087

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962.

SHAW-BARTON, INC.,

Petitioner.

vs.

JOHN BAUMGARTH CO.,

Respondent.

On Petition For a Writ of Certiorari
To The United States Court of Appeals
For the Seventh Circuit

REPLY BRIEF FOR PETITIONER.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962.

No. 1087

SHAW-BARTON, INC.,

Petitioner,

vs.

JOHN BAUMGARTH CO.,

Respondent.

On Petition For a Writ of Certiorari
To The United States Court of Appeals
For the Seventh Circuit

REPLY BRIEF FOR PETITIONER.

The Petition tendered to this Court two major questions, and supported them with reasons and citations which challenged Respondent and invited direct and fair replies. Respondent's brief does not contain such replies.

Rather, respondent has largely evaded the challenge and sought to *read into or* graft upon the Appellate Court majority opinion and the trial court opinion certain statements or conclusions not actually employed by the writers of those opinions nor reasonably inferable therefrom. Instances thereof follow.

1. For example, on page 2, lines 9-10, the brief positively states that the Court of Appeals *found* that Homemaker *had not acquired a secondary meaning.* No such finding was made. The court ignored evidence thereof by an assumption that it did not *exist.*

2. On page 4 in answer to "alleged reason three", the brief states that the Court of Appeals *disagreed* that the record contained ample proof of secondary meaning.

The Court of Appeals stated no such *disagreement.* It made the naked assumption in its opinion, printed at petition page 3a, *that because the trial judge made no finding that the mark had acquired a secondary meaning, we may assume that none existed".* The Court dropped the subject right then and there. It was wholly satisfied with its assumption,—even if Judge Hastings was not.

3. Respondent regrets the unadorned assumption and recognizes that the terse and conclusive foregoing assumption of the majority opinion needs a little helpful interpretation and embellishment. So the brief, at the bottom of page 4, states that the assumption is also the *equivalent* of saying that "a study of the record failed to lead to a different conclusion." Judge Minton, in *Wilhartz* v. *Turco,* CA 7th, 164 F2d 731, 733 made a positive statement (see Petition p. 7) that the court had studied the record for evidence of secondary meaning and he thereupon analyzed some of the evidence. In this case, if the majority had done likewise, would they not have plainly said so, especially when supposedly relying on Judge Minton's opinion?

4. In the first three lines at the top of page 5 of its brief, the Respondent reads into or grafts upon the Appellate Court opinion some further interpretation, which is ridiculous and contrary to the court's bald assumption.

5. Not content with bolstering the Appellate Court opinion, the brief at the top of page 5, lines 3 and 4, makes the astonishing and untrue assertion "that the trial court's opinion was to the same effect on this point,"

without, of course, directing this Court's attention to where in Judge Robson's opinion and findings he made or indicated such a finding of secondary meaning.

6. Being then carried away with this line of thought, Respondent at the top of page 5, in italics, lets go with both barrels, and asserts that plaintiff's failure to prove secondary meaning led, first, to the Appellate Court's *assumption*, and second, to no finding of secondary meaning by the trial court. Neither statement is true.

The majority opinion states nothing more than that its assumption is based on the absence of a certain finding by the trial court (Petition p. 3a).

The trial court (Appendix p. 110) held the mark not *descriptive* but *suggestive*, and Respondent's Brief, page 5, last paragraph, admits that a non-descriptive mark needs no secondary meaning. Indeed, it is the settled law that a *suggestive* mark needs no proof of secondary meaning. *Huntington Laboratories* v. *Onyx Oil and Chemical Co.*, 165 F2d 454 (CCPA-1948), quoted on page 9 of the Petition. To the same effect is *Watkins Products Inc.* v. *Sunway Fruit Products Inc.*, CA 7th, 311 F2d 496, 499.

7. Respondent's Brief essays a venture into clairvoyance in the middle paragraph on page 5, noting that petitioner had first raised its reliance on 15 U.S.C. 1052 (f) in its Reply Brief in support of Petition for Rehearing. That much was true, but the brief then states that the Appellate Court *found the contention lacking in merit*. That court made no such finding,—it simply denied the petition, which was urged on several grounds. Petitioner fully recognizes that 15 U.S.C. 1052(f) is directed to the Commissioner of Patents. Its importance here is that if 5 years of use has the evidentiary value there defined to constitute *prima facie* evidence that a mark has become

distinctive of a user's goods, the much longer usage by Shaw-Barton of its mark furnishes practically conclusive proof of distinctiveness (*i.e.* secondary meaning), unless contradicted by some persuasive evidence, which this record most certainly lacks.

Referring now to Respondent's Rebuttal, beginning on page 4, the first "Answer" is incorrect. In adopting its *assumption based* on an *absent finding*, the majority of the Court of Appeals chose to rely on its assumption and decline to examine and weigh the evidence of secondary meaning. That act alone was a denial and a deprivation of Appellee's right to rely on any and all evidence in the record which might support the ultimate judgment rendered by the trial court.

It is not the law in the Federal Courts, nor in the State of Illinois that the absence of a finding of fact in an equity suit may be construed as a negative finding on the point by the trial judge. Respondent has not cited and cannot cite any case contradicting this above statement.

As Petitioner contended before the trial court that its mark was not descriptive, and the court so held, it did not ask for a finding that the mark had acquired a secondary meaning, and this was proper as is pointed out in the *Huntington* v. *Onyx* case, cited and quoted from on page 9 of the Petition.

Respondent submitted 19 proposed findings of fact to the trial court, but not any finding that the mark had not acquired a secondary meaning.

But in its Petition for Rehearing, the Appellee did vigorously assert that it was entitled to have the evidence in the record on this point considered. The denial of the Petition for Rehearing was a further denial of Appellee's

rights in this matter and under the law cited on pages 5 to 12 of this Petition, it is believed that Petitioner has shown an imperative reason for the grant of this Petition.

The "alleged reason two" framed by Respondent on page 4 of its brief is not one of the "reasons" proffered as such by Petitioner for the granting of this Petition. However, this point of law was discussed to show why Judge Robson did not need to support his judgment by a finding of secondary meaning, and the Petition so states this at page 9.

The point is further involved in the consideration of Petitioner's Question No. 2. If a court correctly interprets 15 U.S.C. 1052(e), and follows the decisions discussed on pages 12 and 13 of the Petition the court will in any case like the present one hold that a mark which is the name of a prospective user of the trademarked goods is *merely a suggestive* mark, needing no proof of secondary meaning.

Respondent's brief appears to take the position in reference to "alleged reason three" that Petitioner urges this Court to grant the petition because the record contains ample evidence of proof of secondary meaning. Respondent's position is misleading and incorrect. This would not be a recognized reason for granting the writ.

But when, as here, a Petitioner charges that the Appellate Court has violated Appellee's right to support his judgment by any evidence of record, it is incumbent upon the petitioner to show the Supreme Court what the evidence is in the record whose use he was denied. This we have done, and what we have alluded to is some of the evidence mentioned by Judge Hastings in his dissenting opinion, printed in the Petition at pages 5a and 6a.

Coming to "alleged reason four", Respondent correctly identified a title relating to the Question No. 2, but then declined to discuss what is a proper judicial interpretation of 15 U.S.C. 1052(e).

In the Court of Appeals, the Appellee, Shaw-Barton, cited *Hamilton-Brown* v. *Wolf Bros.*, 240 U.S. 251, 256, 257 as well as *Bonne-Belle* v. *Lanolin Plus Cosmetics Co.*, 202 F2d 790, 792 and *Hansen* v. *Triangle Publications Inc.*, 163 F2d 74 in support of its trademark.

Appellee was amazed later to find the majority opinion employing these first two cases to support allegedly a finding that the mark was descriptive.

The majority opinion then turned to 15 U.S.C. 1052(e) for the same support, but it is thought that the majority opinion does not reflect a correct interpretation of the statute.

It is noted that Respondent's brief did not undertake to justify the court's application of these cases, which would have been, indeed, difficult.

The Court of Appeals in the immediately foregoing *Bonne Belle* case reversed the Commissioner of Patents who had held that a mark which was the name of a prospective customer was descriptive in the sense of the statute 15 U.S.C. 1052(e). The court said, at page 791, "But to permit such a finding or belief to be, if not all controlling in its decision, certainly predominating in the reason applied, as was done in this case, *is going far beyond even a most liberal expansion of the statute* and to *an extent we cannot approve.*" (Emphasis added).

The Supreme Court itself has not yet interpreted 15 U.S.C. 1052(e) on the above point considered in the *Bonne Belle* case. But in 1916, when the Trademark Act

of 1905 was in force, this Court did cover this point in a very authoritative fashion in *Hamilton-Brown Shoe Co.* v. *Wolf Bros.*, 240 U.S. 251, 256, 257. The trademark of plaintiff Wolf Bros. was "The American Girl" applied to women's shoes, and defendant's mark was "American Lady," likewise applied to women's shoes. At 240 U.S. 256, 257, the Court said:

> "We do not regard the words 'The American Girl' adopted and employed by complainant in connection with shoes of its manufacture as being a geographical or descriptive term. It does not signify that the shoes are manufactured in America, or intended to be sold or used in America, nor does it indicate the quality or characteristics of the shoes. Indeed, it does not, in its primary signification, indicate shoes at all. It is a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture. We are convinced that it was subject to appropriation for that purpose * * * 'The American Girl' would be descriptive of almost any article of manufacture, that is to say, not descriptive at all."

There is a violent conflict between the Seventh Circuit's current interpretation of 15 U.S.C. 1052(e) and the decisions cited by Petitioner on page 12 of its petition. The Seventh Circuit noted but refused to follow the wise decision of this Court in the *Hamilton-Brown* case. Now that the Lanham Act has superseded the Act of 1905, it is respectfully submitted that this Court should take this case for review and announce whether it will interpret 15 U.S.C. 1052(e) consistently with the cited decisions or will support the current decision of the Seventh Circuit in this case.

CONCLUSION

Question No. 1 has presented to this Court an instance of the denial of an Appellee's "inveterate and certain" right to rely on any and all evidence of record to support the judgment of the trial court. That denial is in violent conflict with numerous decisions of this Court, and in such denial the Appellate Court has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

Petitioner represents that it is apparent from the record and this Petition that the errors adverted to in Questions No. 1 and No. 2 are important to the proper administration of the trademark laws, the proper conduct of appellate review, and involve matters and principles the settlement of which is of importance to the public. It should be noted that no other Court of Appeals invokes, in an equity suit, the "absent finding" "assumption" as was done here and no other court has denied Appellee's rights as above discussed.

Respectfully submitted,

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